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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,329	09/30/2003	Mark McCormick	700706.90181	5309

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EXAMINER

TRAN, MY CHAU T

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/675,329	<b>Applicant(s)</b> MCCORMICK ET AL.	
	<b>Examiner</b> MY-CHAU T. TRAN	<b>Art Unit</b> 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>See Office Action</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

*Application and Claims Status*

1. Claims 1-16 are pending.

*Election/Restrictions*

2. Applicant's election with traverse of Group II (Claims 7-13) in the reply filed on 05/0/2006 is acknowledged.

The traversal is on the ground that Group I (Claims 1-6) and Group III (Claims 7-13) should be rejoined with Group II because the same array synthesizer described in the specification is use to make the array of Group I (Claims 1-6) and in the methods of Groups II (Claims 7-13) and Group III (Claims 14-16). Thus, there is no burden to search the inventions of all Groups.

This is not found persuasive because there is a search burden for 1) the inventions of Groups I, II, and III do not claim a 'share' array synthesizer, 2) the instant specification describe two different apparatuses wherein one apparatus is a conventional apparatus for synthesizing probe onto subarray or probe areas (see specification pg. 4, [00016], lines 1-4) and the second apparatus is a MAS<sup>TM</sup> instrument that is use to make the alignment marks on the array (see specification pg. 5, [00018], lines 1-5), and 3) each group have acquired a separate status in the art in view of their different classification and are involved in different patentability considerations. Accordingly, the searches required are not co-extensive thus requiring a burdensome search, and the requirement is still deemed proper and is therefore made FINAL.

Art Unit: 1639

3. Additionally, since applicant ***did not*** elected to prosecute the product claims (i.e. Group I: Claims 1-6), applicants are advised that applicant has loss the right to the rejoinder of the process claims with the product claims in accordance with the court decisions in *In re Ochiai*, (71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995), and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996). Moreover, applicant was advised of the right to rejoinder and its condition for the rejoinder with regard to the product claims and process claims in the Office Action mailed 03/20/2006.

4. Applicant has elected with traverse the following species for the elected invention (Claims 7-13) in the reply filed on 05/08/2006:

- a. For the single specific species of hapten, applicant elected biotin.
- b. For the single specific species of reporter molecule, applicant elected horseradish peroxidase.

Because applicant did not distinctly and specifically point out the supposed errors in the species election requirement, the traversal is moot and the species requirement is still deemed proper and is therefore made FINAL.

***Priority***

5. This instant application claims benefit to a provisional application of 60/415,119 filed 09/30/2002. This instant application is granted the benefit of priority for 60/145,119 under 35 U.S.C. 119(e).

***Information Disclosure Statement***

Art Unit: 1639

6. The information disclosure statements (IDS) filed on 11/17/2003 and 01/12/2004 have been reviewed, and the references that have been considered are initialed as recorded in PTO-1449 form(s).

7. Claims 7-13 are under consideration in this Office Action.

***Claim Objections***

8. Claim 11 is objected to for depending on Claim 6, which is a product claim and not a method claim. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 7-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) The phrase "microarray slide" of claim 7 is vague and indefinite because it is unclear if this structure is synonymous with the term "microarray" or refers to a different structure.

b) Claim 8 recites the acronym of "DNP" is vague and indefinite because it is not defined in the claim so that those who are ordinary skills in the art would know applicant intended meaning. It should be define on its first appearance.

Art Unit: 1639

c) Claim 12 recites the acronym of "NPPOC" is vague and indefinite because it is not defined in the claim so that those who are ordinary skills in the art would know applicant intended meaning. It should be define on its first appearance.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 571-272-0810. The examiner can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras, Jr., can be reached on 571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

My-Chau T. Tran  
Patent Examiner  
August 21, 2006

